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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,245	10/16/2001	Frederick C. Dupre JR.	005242.00019	2241
22907	7590	07/09/2004	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			TRUONG, DUC	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/977,245

Applicant(s)

DUPRE, FREDERICK C.

Examiner

Duc Truong

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0625</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1-19 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/14/04.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Database WPI of record on 1449.

The reference discloses ethylene carbonate (or hardener) and an alkaline substance (or hardening accelerator) are added to thermosetting resin and the resulting mixture is hardened at room temperature.

Note that the thermosetting resin comprising resole type phenol resins.

Note also that the amount of ethylene carbonate used is from 1-100/100 wt% of thermosetting resin, overlapped with these in the claims.

Note also that the amount of alkaline substance used is from 3-300parts wt/100 pts wt ethylene carbonate. If said wt% is converted and compared to the resin, it would be overlapped.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerber or GB 1374332, both of record on 1449.

Gerber reference discloses method and compositions for accelerating the hardening of phenolic resole resins admixed with hardening quantities of Magnesium oxide or magnesium hydroxide, either alone or together with an ester functional hardening agent which is accelerated by certain amines (see Abstract and at col. 3, lines 22-24).

Note that the ester hardening agents comprising cyclic organic carbonates including propylene carbonate, ethylene glycol carbonate, butanediol carbonate---(see col. 8, line 14 et seq.) with specific wt ratios (see col. 9, line 44-45).

Note also that the tertiary amines are accelerators and have been disclosed at col. 13, line 59 et seq.

The disclosure of the reference differs from the instant claims in that the instant claims do not require the presence of magnesium oxide or magnesium hydroxide.

However, it does disclose the use of accelerators such as cyclic carbonate and amines.

Therefore, it would have been obvious to one of ordinary skill in the art to omit the magnesium oxide or magnesium hydroxide and its function and employed accelerators as claimed since the omission of an element and loss of its function from a combination is obvious in the absence of a showing of unexpected results derived from such omission. See *In re Wilson*, 153 USPQ 740 (CCPA 1967), *Ex Parte Rainu*, 168 USPQ 375.

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1374332 of record on 1449.

The reference discloses the use of a curing agent mixture consisting of 25% of ethylene carbonate and 75% of formamide to accelerate the process to form phenol-formaldehyde resin. (See Example 1)

The disclosure of the reference differs from the instant claims in that it does not disclose the use of amines as accelerator. However, it does disclose the use of formamide having the same functionality with the claimed amines. Therefore, it would have been obvious to one of ordinary skill in the art to select the formamide from the reference to replace said claimed amines since they have been shown to be effective in a similar system and thus would have been expected to provide adequate results. There is no showing of unexpected results derived from said use.

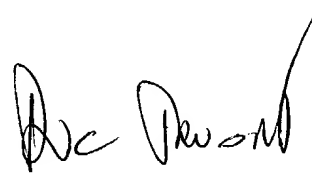
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 571-272-1081. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ductruong', with a long, sweeping flourish extending upwards and to the right.

DUCTRUONG  
PRIMARY EXAMINER

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